

REMARKS

The Examiner believes that applicants' reply of August 19, 2003 to the Examiner's requirement for information under 37 C.F.R. § 1.105 is incomplete. (Office Action, Oct. 31, 2003, p.2.) It appears the Examiner's position is that applicants must submit all information requested by the Examiner even if the information is subject to a protective order. Applicants respectfully disagree.

The Examiner relies upon a section of the MPEP discussing the duty of disclosure under 37 C.F.R. § 1.56 to support his position on a requirement for information under 37 C.F.R. § 1.105. This reliance is misplaced. That section of the MPEP pertains only to the duty of disclosure and not to a requirement for information. (The duty and the requirement are unrelated, except that the class of people covered by the requirement includes the people covered by the duty.) In addition, the threshold under the duty of disclosure ("material to patentability") is substantially higher than under a requirement for information ("reasonably necessary"). (MPEP 704.12(a).) As a result, the Patent Office expects that, when information meets the high threshold under the duty of disclosure, the individual will disclose the information even if a protective order needs to be modified because it is assumed to be material. When the information, however, does not meet that high standard, the Patent Office only expects that "information reasonably and readily available" need be provided. (Id.)

Applicants are not obligated under § 1.105 to provide information that is not readily available. Clearly, information covered by a protective order is not readily available when an applicant is prohibited by court order from providing such information to the Patent Office. In compliance with § 1.105(a)(3), applicants state that any information covered by the requirement for information in the Office Action of March 18, 2003 and not provided in the reply of August 19, 2003 is not readily available to the individuals identified under 1.56(c) or the assignee, Amazon.com (the "1.105 parties"). This statement is a "complete reply to the requirement for information." (65 Fed. Reg. 54634, Sept. 8, 2000 *and see* 37 C.F.R. § 1.105(a)(3).)

The Examiner has issued a new requirement for information relating to BountyQuest. Applicants would first like to correct the Examiner's mischaracterization of the article entitled "The Pros and Cons of Patents," by Robert Godbey. First, it is the Examiner's position that the article "states that Amazon.com owned BountyQuest." (Office Action, Oct. 31, 2003, p. 3.) The article makes no such statement. Rather, the article states (and correctly so) only that Amazon.com's chief executive officer (who is a co-inventor) provided startup funding. Amazon.com has neither owned nor invested in BountyQuest. Second, it is also the Examiner's position that the article states "that Amazon.com . . . paid persons for relevant art." (Id.) Again, the article makes no such statement. Rather, the article states only that BountyQuest paid for such prior art. Amazon.com has not paid for any such prior art.

More specifically, Amazon.com has never been affiliated with BountyQuest. None of the 1.105 parties has ever commissioned any bounty through BountyQuest. As the applicants understand it, BountyQuest paid for and commissioned the bounty in an effort to generate publicity for their service. The 1.105 parties never received a copy of the complete results of the bounty and have only heard of the results through various published articles. Moreover, since BountyQuest is out of business, the 1.105 parties can not contact it to ask for the results. Applicants are citing a copy of a BountyQuest web page obtained via the web archives of "web.archive.org." That web page purports to list "1-Click Prior Art." The following table lists the references mentioned in the web page. Specifically, the references are:

| No. | Reference Description | Date Cited |
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| 1. | "Open TV Claims Patent on 'One Click'." CBSMarketwatch.com web article. October 5, 2000. | 02/02/04 |
| 2. | Baron, Chris and Bob Weil. "Implementing a Web Shopping Cart." <i>Dr. Dobb's Journal</i> . September 1996. | 05/25/99 |
| 3. | U.S. Patent No. 5,963,924 | 07/12/02 |
| 4. | U.S. Patent No. 4,739,310 | 02/02/04 |
| 5. | U.S. Patent No. 4,734,858 | 07/12/02 |

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| 6. | U.S. Patent No. 5,303,393 | 07/12/02 |
| 7. | U.S. Patent No. 5,208,748 | 02/02/04 |
| 8. | Kristol, David M. and Lou Montulli. "HTTP State Management Mechanism." Hypertext Markup Language – 2.0. Nov. 1995 | 08/18/03 |
| 9. | Auction Features – Strictly Exchange Online Auction Software, http://www.auctionhosting.com . August 1, 1997. | 07/12/02 |
| 10. | Greenspun, Philip. "Philip and Alex's Guide to Web Publishing," Chapter 14: <u>eCommerce</u> . September 1998. | 07/12/02 |
| 11. | "The Everchanging Marketplace." The Forum. August 18, 1999. | 02/02/04 |
| 12. | "The Web Maestro: An Interview with Tim Berners-Lee." MIT Technology Review. July 1996. | 02/02/04 |
| 13. | "Shopping Models: A Flexible Architecture for Information Commerce Proceedings of the 2 nd ACM International Conference on Digital Libraries", ACM Press 1997. Philadelphia, PA. July 25-28, 1997. | 02/02/04 |
| 14. | Bank of Montreal MBANX, "Netbanking With Your PC," July 7, 1997 | 07/12/02 |
| 15. | "Description of Shopping Cart Options." Descriptive Text and Computer Code from the Online Exchange, Inc. August 28, 1997. | Unable to obtain |
| 16. | "MiniVend – Multi-Catalog Shopping Cart and Mall." Online Minivend Reference Guide. March 14, 1997. | 02/02/04 |
| 17. | Simple Internet Purchase Procedure. | Unable to obtain |
| 18. | U.S. Patent No. 5,819,034 (EP Patent equivalent #0680 185 A2) | 10/10/00 |
| 19. | International Patent No. WO 96/17466 | 02/02/04 |
| 20. | Walter's Coke Project Homepage, "Lloyd's Coke Machine," Feb.27, 1996 | 07/12/02 |
| 21. | Telvue Corp. 10-Q Report, Nov. 7, 1995 | 07/12/02 |

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| 22. | Doonesbury Comics, May 2, 1993 through May 8, 2003 | 08/18/03 |
| 23. | <u>Star Trek</u> , the television series 1987-1997. | Unable to obtain |
| 24. | Norm on <u>Cheers</u> Television Show, November 10, 1982. | Unable to obtain |
| 25. | "Interactive System Productivity." ISPF V4R2.0 User's Guide. October 9, 1995. | Unable to obtain |

Applicants had previously supplied copies of those references believed to be most relevant. As requested by the Examiner, applicants are now citing those additional references that applicants were able to obtain.

Applicants respectfully request consideration of this application and its early allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-8548.

Respectfully submitted,

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